

**RECEIVED
CENTRAL FAX CENTER**

MAY 08 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Morgan)	Art Unit: 2182
)	
Serial No.: 09/933,494)	Examiner: Martinez
)	
Filed: August 20, 2001)	ARC9-2001-0079US1
)	
For: SYSTEM AND METHOD TO USE UNMODIFIED)	May 8, 2006
OPERATING SYSTEM ON DISKLESS COMPUTER)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

REPLY BRIEF

This responds to the Examiner's Answer dated May 2, 2006.

The Answer "finds" that the specification, which teaches in plural places (according to the "findings") that disk I/O requests are transformed to network requests, nonetheless "fails to provide support for what entails a translation operation", and instead "merely discloses the forwarding of a local I/O request to a network request." In this way, an overly broad claim interpretation is rationalized.

Claims must be interpreted as one skilled in the art would interpret them in light of the specification, MPEP §2111.01. In essence, the Answer makes a correct finding of fact - that Appellant has expressly disclosed "transforming" one request into another request - but then draws an ultimate legal conclusion from it, namely, that the skilled artisan would erase the word "transform" from the claims and substitute the word "forward" - that is nowhere supported by a finding of fact based on evidence of record. Indeed, the word "forward" is not found in the present specification. Apart from an unwillingness to allow the claims, why would the examiner believe that the skilled artisan would substitute the word "forward" for the word "transform?"

1053-129.RPL

BEST AVAILABLE COPY

CASE NO.: ARC9-2001-0079US1
Serial No.: 09/933,494
May 8, 2006
Page 2

PATENT
Filed: August 20, 2001

Thus, the gravamen of the Answer appears to be that unless a term is specifically defined in the specification, it may be changed at will without any evidence to support the change. With respect to the Answer's observation that the specification does not provide details of the "transform" operation, Appellant notes the following. First, the Answer fails to note the sentence following the relied-upon page 5, lines 20-23 that relates to transformation: "For example, the adapter 26 can access data, including operating system files, that are stored in a network storage device 28 using the network 12." Thus, the Answer does not fully or fairly treat what the specification teaches regarding "transforming."

Second, the issue is not a written description or enablement issue, but rather one of claim construction. Were it a Section 112 issue, Appellant could have provided evidence that the disclosure as is sufficiently alerts one skilled in the art what to do, namely, to transform an I/O request into a network request, in light of the knowledge of one skilled in the art as might have been evidenced, e.g., by a Rule 132 declaration. However, no 112 issue has been raised by the examiner, which leads back to square one. No matter how lightly the examiner believes Appellant has treated the "transform" operation, he simply cannot equate it to a "mere forwarding" by *dictat*, without evidence that one skilled in the art, when faced with the requirement to "transform" a disk I/O request to a network request, would consider "mere forwarding" of the disk I/O request to comply.

Indeed, the Answer admits as much on page 9, lines 4 and 5 ("Appellant requires receiving disk I/O requests and then *sending them as network I/O requests*") (emphasis mine.) What is this if not a tacit recognition that more than "mere forwarding" is required by the claims?

With respect to the obviousness rejections, the Answer provides the usual boilerplate legal discussion of what is required to make a *prima facie* case but then typically misapplies the law, relying not on any

1053-129.RPL

CASE NO.: ARC9-2001-0079US1
Serial No.: 09/933,494
May 8, 2006
Page 3

PATENT
Filed: August 20, 2001

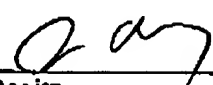
specific suggestion but rather on unsupported "knowledge of one skilled in the art", page 11, lines 12 and 13 of the Answer. The suggestion to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases from the nature of the problem, but "more often [the suggestion] comes from the teachings of the pertinent references". The range of sources available does not diminish the requirement for **actual evidence**, and "broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence", In re Dembiczak, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). As set forth in Dembiczak, "the best defense against the subtle but powerful attraction of hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references", Id. at 999, 50 U.S.P.Q.2d at 1617. Indeed, "rarely will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgement....Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process", rejecting an obviousness argument by disapprovingly noting that the party asserting obviousness "is unable to point to any specific teaching or suggestion for making this combination. VSI instead relies on what it presumes is the level of knowledge of one of ordinary skill in the art at the time of the invention to supply the missing suggestion to combine", Al-Site Corp. v. VSI Int'l. Inc., 174 F.3d 1308, 50 USPQ.2d 1161 (Fed. Cir. 1999). Accordingly, absent evidence supporting the alleged knowledge in the art, the rejections fall.

1053-129.RPL

CASE NO.: ARC9-2001-0079US1
Serial No.: 09/933,494
May 8, 2006
Page 4

PATENT
Filed: August 20, 2001

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

1053-129.RPL